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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,808	12/19/2001	Lee E. Cannon	5012US (01-03-047)	9445

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EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,808

Applicant(s)

CANNON ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-49 is/are allowed.
- 6) ☒ Claim(s) 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendment filed November 19, 2003 (paper No. 9) has been received and considered. By this amendment, claims 1-20 have been canceled, claims 21-49 have been added and claims 21-49 are now pending in the application.

Claim Objections

1. Claims 35 is objected to because of the following informalities:

In claim 35, line 2, the claimed limitation "a player" should be corrected to "the player" to provide proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 21-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a) In claim 21, line 5, the claimed limitation "collectively" is ambiguous. Because it is not clear how the one selection space be collected?

- b) Claims 31 and 37 are similarly rejected as explained in claim 21 above.

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- c) Claims 22-30, 32-36, and 38-42 are rejected as being dependent on the rejected base claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 21, 25, 27-28, 30, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Nulph (US. Patent No. 6,234,899).

- a. As per claim 21, 25, 27-28, and 30, Nulph discloses a multiple entry game form comprising a plurality of game spaces (play A and play B in Fig. 3A) with the fixed number of selection spaces 1-80 (Fig. 3A), and a unique gaming space indicator (player A, play B in Fig. 3A), a selection space associated with a gaming space collectively defining a game set (Fig. 3C).
- b. As per claim 37, refer to discussion in claim 21 above. Further, Nulph discloses a selectable selection space 1, 10, 71, and 80 (Fig. 3C) and a unique indicator (play A, play B).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-23, 26, 29, 31, 36, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nulph (US. Patent No. 6,234,899).

a. As per claim 22-23 and 38-39, Nulph discloses that the form is in computer readable format (col. 3, lines 35-36). Further, printing indicia on a substrate would have been well known to a person of ordinary skill in the art at the time the invention was made. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to print the indicia on a substrate, since selecting a specific material for a game form requires only routine skill in the art.

b. As per claim 26, 29, and 36, displaying an image shape of four leaf clover, displaying game statistics of a player would have been well known to a person of ordinary skill in the art at the time the invention was made.

c. As per claim 31, refer to discussion in claim 21 above. Further, including an input element and a controller for processing the player input would have been well known.

7. Claims 24, 32-35, and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nulph (US. Patent No. 6,234,899) in view of McNabola (US. Patent No. 6,368,213).

a. As per claim 24, 32-33, and 40, McNabola discloses displaying the image of the game form on a video display and providing a player input element, which is a touch screen, or an element for indexing a cursor (col. 2, lines 11-17). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to display the game form and to provide the player input element of McNabola to the game of Nulph in order to allow the player to input the game form using a video game machine.

b. As per claim 34, McNabola discloses presenting random outcome by altering the displayed game space indicator (col. 5, lines 11-16).

c. As per claim 35 and 41-42, displaying game statistic would have been well known.

Allowable Subject Matter

8. Claims 43-49 are allowed.

9. The following is a statement of reasons for the indication of allowable subject matter:

Prior arts of record does not disclose a multiple game entry form which comprises a plurality of gaming spaces, each gaming space includes a unique indicator and has four selectable selection spaces; a first selection space disposed in a first corner of each gaming space, the first selection spaces collectively defining a first game set; a second selection space disposed in a second corner of each gaming space, the second selection spaces collectively defining a

second game set; a third selection space disposed in a third corner of each gaming space, the third selection spaces collectively defining a third game set; and a fourth selection space disposed in a fourth corner of each gaming space, the fourth selection spaces collectively defining a fourth game set.

Response to Arguments

10. Applicant's arguments filed November 19, 2003 have been fully considered but they are not persuasive.

a) In response to applicant's argument in page 11, last paragraph, and page 13, first paragraph, independent claims 21, 31, and 37 do not explicitly claim that the game set is defined according to the spaces of both plays. Further, the claim language "collectively" is ambiguous (refer to the 35 USC 112-second paragraph rejection above) and does not imply the "both plays".

b) In response to applicant's argument in page 12, last paragraph, Nulph teaches providing a game form on a computer. Further, McNabola teaches a video display which is capable of displaying a game form (col. 2, lines 11-17). An ordinary person skill in the art at the time the invention was made would able to use the video display of McNabola to display two separate game spaces (play A and play B) of Nulph on the known video display of McNabola when the video display is implemented on the game machine of Nulph. Therefore, reference of McNabola does not teach away from the game machine of Nulph.

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Hand-delivered responses should be brought to Crystal Plaza II, Arlington, VA
Second Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn
Date: January 30, 2004


KIM NGUYEN
PRIMARY EXAMINER